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OFFICE OF PETITIONS

In re Application of :
Carlton G. Willson, et al. :
Application No. 10/776,881 : DECISION DISMISSING
Filed: February 11, 2004 : PETITION
Attorney Docket No. PA84/UTS-37-03 :
:

This is a decision on the petition filed June 7, 2004, requesting that the above-identified application be accorded a filing date of February 11, 2004, with an indication that page 21 of the specification was present on filing.

The petition is **DISMISSED**.

The application was filed on February 11, 2004. The specification included a written description containing pages 1-20 and an abstract page (page 22). No page number 21 was filed. Accordingly, the Office of Initial Patent Examination mailed a Notice of Omitted Items ("Notice") on May 28, 2004, stating that the application had been accorded a filing date of February 11, 2004, but that page 21 appeared to have been omitted.

In reply to the Notice, petitioner has filed the present petition arguing that page 21 was, in fact, present upon the filing of the application and that the application should include 25 claims instead of 22, as indicated on the application filing receipt. Since the Office does not have page 21 of the specification, claims 23 to 25 were not recorded in the application. In support, petitioner has provided a copy of the application transmittal letter, with an authorization of payment for five (5) additional claims. Petitioner has also provided a copy of an Express Mail label showing the application papers were deposited with the U. S. Postal Service ("USPS") on February 11, 2004, and a copy of a stamped postcard receipt, with a notation from the USPTO stating, "no page 21 of specification."

The arguments are not persuasive. The USPTO ("Office") file is the official record of the papers originally filed in this application. A review of the official file record reveals that page 21 of the specification is not present in the file. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. The copy of the application transmittal sheet, which suggests that 22 pages of specification were filed and an

authorization to charge the deposit account for five (5) additional claims, are not more substantial than the Official record. The application transmittal sheet does not provide more weight than the official record of what was actually mailed to the Office on February 11, 2004. Furthermore, the mere fact that the application papers were deposited with the USPS does not corroborate the allegation that page 21 accompanied those application papers. Indeed, a USPS employee would not be able to attest to what papers were placed in the Express Mail envelope. For that reason, the evidence pertaining to the Express Mail procedures under 37 CFR 1.10 bears no relevance to the situation at hand. As set forth in MPEP 503, "a postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." The additional evidence which petitioner has provided, namely the postcard receipt, clearly shows that page 21 of the specification was not present on filing. Therefore, the postcard receipt does not serve as *prima facie* evidence of receipt in the USPTO of the missing page 21. In view thereof, the application filing receipt will not indicate that page 21 of the specification, including claims 23-25, was present on filing.

Nevertheless, petitioner may submit the omitted page 21 by filing an amendment prior to the first Office action since the specification contains a proper incorporation by reference statement. MPEP 201.06(c)(B) states:

"If a continuation or divisional application as originally filed is entitled to a filing date despite the omission of a portion of the prior application(s), applicant will be permitted to add the omitted material by way of an amendment provided a statement was included in the application as originally filed that incorporates by reference the prior application(s). If the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by way of an amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case, applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.02(d) and § 601.01(g)."

The application file is being referred to the Office of Initial Patent Examination for further processing of the application papers without the omitted page 21 and without claims 23-25.

Telephone inquiries concerning this matter may be directed to Marianne Morgan at (703) 306-3475.


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